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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,079	07/02/2003	Ray C. Wasielewski	ORW01-GN003	5826

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TAFT, STETTINIUS & HOLLISTER LLP  
SUITE 1800  
425 WALNUT STREET  
CINCINNATI, OH 45202-3957

EXAMINER
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RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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06/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/612,079

Applicant(s)

WASIELEWSKI, RAY C.

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-76 and 105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 64 is/are allowed.
- 6) ☒ Claim(s) 1-63, 65-76 and 105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/2/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 17, 20, 41-54, 57 and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferguson (US 6,592,622).

Ferguson discloses a band assembly or "prosthetic stabilizing device" 14 including a resorbable lining that is capable of being mounted to at least one of a tibial component 10 so that the lining is between the tibial component and a femoral component and approximate a prosthetic intercondylar channel (Figs. 1-4 and col. 5, lines 1-59). Note that Ferguson discloses that the prosthesis assembly of his invention can be used with an implanted femoral component which would have an intercondylar channel to interact with bearing insert 32 (col. 9, lines 65-67 and col. 10, lines 1-2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 16, 18, 19, 21, 22, 33-40, 55, 56, 58, 59, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson (US 6,592,622) in view of Scarborough (US 6,616,698).

Ferguson discloses all elements of the claimed invention except for an antibiotic agent such as gentamicin, a clotting factor and osteogenic materials such as stem cells and transforming growth factor.

It is very well known to use gentamicin as an antibiotic and osteogenic materials such as stem cells and transforming growth factor in implants as evidenced by Scarborough (col. 6, lines 17-55).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an antibiotic such as gentamicin and osteogenic materials such as stem cells and transforming growth factor in the Ferguson implant, since it was well known to use these materials for their intended purpose, namely, promoting bone growth and prevention of infection.

Claims 23-25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson (US 6,592,622).

Ferguson discloses a first lining 36 constructed of a resorbable material and a second lining 34 constructed of an inert material. Ferguson also discloses that fasteners or sutures 38 can be used to bind the two linings together (col. 5, lines 1-44 and lines 60-67 and col. 6, lines 1-4).

Ferguson discloses all elements of the claimed invention except for band 34 being constructed of an inert material that is biologically resorbable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed band 34 of an inert material that is biologically resorbable, for e.g. collagen or ECM, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson (US 6,592,622) in view of Yencho et al. (US 6,461,320).

Ferguson discloses all elements of the claimed invention except for a fastener such as a clip.

Yencho teaches the equivalence of sutures and clips for the purpose of connecting two members (col. 4, lines 27-29).

It would have been obvious to one of ordinary skill in the art to substitute a clip as, for example, taught by the Yencho reference for the suture of the Ferguson device wherein so doing would amount to mere substitution of one functionally equivalent fastener for another within the same art and the selection of any of these fasteners would work equally well in the claimed device.

Claims 63, 65-76 and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helfet (RE 29,757) in view of Valentini (US 5,759,205).

Helfet discloses a knee joint prosthesis including a femoral component 16, a tibial component 17 and a lining mounted to a stabilizing post of the tibial component wherein the lining is made of a synthetic resin plastic material (Fig. 7, col. 3, lines 6-68 and col. 4, lines 1-30).

Helfet discloses all elements of the claimed invention except for a biologically resorbable lining or coating.

Valentini teaches applying biodegradable and biologically active materials to implants in the form of a lining or coating to promote implant incorporation into a patient's body (col. 3, lines 21-24, col. 6, lines 55-67 and col. 7, lines 1-31).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a coating or lining of biodegradable material in the Helfet prosthesis, as taught by Valentini, to promote implant incorporation into a patient's body.

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on March 9, 2006 have been fully considered but are not persuasive for the following reasons.

Applicant's arguments with respect to the rejections under 35 USC 102(e) as being anticipated by Ferguson are not persuasive because Ferguson clearly discloses a lining (36, 38) comprising a biologically resorbable material (36).

Applicant's arguments with respect to claims 63, 65-76 and 105 are moot in view of the new ground of rejection.

### ***Allowable Subject Matter***

Claim 64 is allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
May 29, 2007



ANURADHA RAMANA  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3700